

## **REMARKS**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 2, 23-25, 46, 47, 48, 56 and 68 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-69 are now pending in this application.

### **Claim Rejections – 35 U.S.C. § 112**

In section 2 of the Office Action, the Examiner rejected Claims 1-46 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner indicated that “The claim(s) contains subject matter ‘the slot configured to be located overlying a back side of the handheld of the computer’ which was not described in the specification in such a way as to enable one skilled in art to which it pertains, or with which it is most nearly connected to make and/or use the invention.” Applicants respectfully submit that independent Claims 1 and 24 have been amended to clarify the language. In particular, Claim 1 has been amended to recite “an expansion slot defined by a first portion of the SDIO module housing, the expansion slot having an as SDIO interface configured to selectively couple to one of a secure digital (SD) card and a multi-media card (MMC). The first portion of the SDIO module housing configured to be located adjacent a back side of the handheld computer.” Similarly, independent Claim 24 has been amended to recite “an expansion slot defined by a first portion of the SDIO module housing coupled to the SDIO module. The first portion of the SDIO module housing located adjacent a back side of the housing, the expansion slot having an SDIO interface configured to selectively couple to one of a secure digital (SD) card and a multi-media card (MMC).

Applicants assert that the claim limitation as amended is enabled by a combination of the figures and specification. For example, Applicants refer the Examiner to Figures 2, 3, 4, and 5 which depict an SDIO module having a slot 150 in a portion of the SDIO module 130 housing and an SD card 160 is being shown being inserted into the slot. The portion of the housing containing the slot receiving card 160 is shown adjacent back side of the handheld computer in Figures 3, 4, and 5. Accordingly, Applicants assert that the subject matter of independent Claims 1 and 24 are enabled and request the withdrawal of the rejection of Claims 1-46 under 35 U.S.C. § 112.

### **Claim Rejections – 35 U.S.C. § 103**

In section 3 of the Office Action, the Examiner rejected Claims 47-49, 52, 54-55, 61, 64, and 66-67 under 35 U.S.C. § 103(a) as being unpatentable over Ito et al. (U.S. Patent 2001/0042149) in view of “Socket to Support World’s Smallest Plug-in Card for Mobile Connectivity” (SDA).

Applicants respectfully traverse these objections. Each of these rejections relies in part on the use of Ito et al. However, Applicants submit that Ito et al. is unavailable as a prior art reference against Claims 47-49, 52, 54-55, 61, 64, and 66-67 of the present application. A declaration of the inventors pursuant to 35 CFR § 1.131 has been provided herewith which provides evidence that the subject matter recited in Claims 47-49, 52, 54-55, 61, 64, and 66-67 was invented prior to the filing date of Ito et al. Ito et al. was filed on December 28, 2000 as U.S. Application No. 09/748,856. The attached signed Declaration establishes that the subject matter recited in Claims 47-49, 52, 54-55, 61, 64, and 66-67 was conceived by the inventors at least by December 11, 2000, which is before the December 28, 2000 filing date of Ito et al.

Accordingly, the Applicants submit that Ito et al. is unavailable as a prior art reference against Claims 47-49, 52, 54-55, 61, 64, and 66-67 and therefore respectfully request that the rejection of Claims 47-49, 52, 54-55, 61, 64, and 66-67 be withdrawn.

In section 4 of the Office Action, the Examiner rejected Claims 50-51 under 35 U.S.C. § 103(a) as being unpatentable over Ito et al. and SDA and further in view of Petty (U.S. Patent No. 6,389,486).

Applicants respectfully traverse these rejections. Each of these rejections relies in part on the use of Ito et al. However, Applicants submit that Ito et al. is unavailable as a prior art reference against Claims 50-51 of the present application. A Declaration of the inventors pursuant to 37 CFR § 1.131 has been provided herewith which provides evidence that the subject matter recited in Claims 50-51 was invented prior to the filing date of Ito et al. Ito et al. was filed on December 28, 2000 as U.S. Patent Application No. 09/748,856. The attached signed Declaration establishes that the subject matter recited in Claims 50-51 was conceived at least by December 11, 2000. Attachments to the Declaration include an Invention Disclosure form that establishes that the subject matter recited in Claims 50-51 was conceived by the inventors at least by December 11, 2000 which is before the December 28, 2000 filing date of Ito et al.

Accordingly, the Applicants submit that Ito et al. is unavailable as a prior art reference against Claims 50-51 of the present application, and therefore respectfully request that the rejection of Claims 50-51 be withdrawn.

In section 5 of the Office Action, the Examiner rejected Claim 53 under 35 U.S.C. § 103(a) as being unpatentable over Ito et al. and SDA and further in view of Hawkins et al. (U.S. Patent No. 6,442,637).

Applicants respectfully traverse these rejections. Each of these rejections relies in part on the use of Ito et al. However, Applicants submit that Ito et al. is unavailable as a prior art reference against Claim 53 of the present application. A Declaration of the inventors pursuant to 37 CFR § 1.131 has been provided herewith which provides evidence that the subject matter recited in Claim 53 was invented prior to the filing date of Ito et al. Ito et al. was filed on December 28, 2000 as U.S. Patent Application No. 09/748,856. The attached signed Declaration establishes that the subject matter recited in Claim 53 was conceived at least by December 11,

2000. Attachments to the Declaration include an Invention Disclosure form that establishes that the subject matter recited in Claim 53 was conceived by the inventors at least by December 11, 2000 which is before the December 28, 2000 filing date of Ito et al.

Accordingly, the Applicants submit that Ito et al. is unavailable as a prior art reference against Claim 53 of the present application, and therefore respectfully request that the rejection of Claim 53 be withdrawn.

In section 6 of the Office Action, the Examiner rejected Claim 56 under 35 U.S.C. § 103(a) as being unpatentable over Ito et al. and SDA and further in view of Jones (U.S. Patent No. 6,145,046).

Applicants respectfully traverse these rejections. Each of these rejections relies in part on the use of Ito et al. However, Applicants submit that Ito et al. is unavailable as a prior art reference against Claim 56 of the present application. A Declaration of the inventors pursuant to 37 CFR § 1.131 has been provided herewith which provides evidence that the subject matter recited in Claim 56 was invented prior to the filing date of Ito et al. Ito et al. was filed on December 28, 2000 as U.S. Patent Application No. 09/748,856. The attached signed Declaration establishes that the subject matter recited in Claim 56 was conceived at least by December 11, 2000. Attachments to the Declaration include an Invention Disclosure form that establishes that the subject matter recited in Claim 56 was conceived by the inventors at least by December 11, 2000 which is before the December 28, 2000 filing date of Ito et al.

Accordingly, the Applicants submit that Ito et al. is unavailable as a prior art reference against Claim 56 of the present application, and therefore respectfully request that the rejection of Claim 56 be withdrawn.

In section 7 of the Office Action, the Examiner rejected Claims 57-59 under 35 U.S.C. § 103(a) as being unpatentable over Ito et al. and SDA and further in view of Nakashima (U.S. Patent No. 6,182,204).

Applicants respectfully traverse these rejections. Each of these rejections relies in part on the use of Ito et al. However, Applicants submit that Ito et al. is unavailable as a prior art reference against Claims 57-59 of the present application. A Declaration of the inventors pursuant to 37 CFR § 1.131 has been provided herewith which provides evidence that the subject matter recited in Claims 57-59 was invented prior to the filing date of Ito et al. Ito et al. was filed on December 28, 2000 as U.S. Patent Application No. 09/748,856. The attached signed Declaration establishes that the subject matter recited in Claims 57-59 was conceived at least by December 11, 2000. Attachments to the Declaration include an Invention Disclosure form that establishes that the subject matter recited in Claims 57-59 was conceived by the inventors at least by December 11, 2000 which is before the December 28, 2000 filing date of Ito et al.

Accordingly, the Applicants submit that Ito et al. is unavailable as a prior art reference against Claims 57-59 of the present application, and therefore respectfully request that the rejection of Claims 57-59 be withdrawn.

In section 8 of the Office Action, the Examiner rejected Claims 60 and 69 under 35 U.S.C. § 103(a) as being unpatentable over Ito et al. and SDA and further in view of Yu (U.S. Patent No. 6,362,794).

Applicants respectfully traverse these rejections. Each of these rejections relies in part on the use of Ito et al. However, Applicants submit that Ito et al. is unavailable as a prior art reference against Claims 60 and 69 of the present application. A Declaration of the inventors pursuant to 37 CFR § 1.131 has been provided herewith which provides evidence that the subject matter recited in Claims 60 and 69 was invented prior to the filing date of Ito et al. Ito et al. was filed on December 28, 2000 as U.S. Patent Application No. 09/748,856. The attached signed Declaration establishes that the subject matter recited in Claims 60 and 69 was conceived at least by December 11, 2000. Attachments to the Declaration include an Invention Disclosure form that establishes that the subject matter recited in Claims 60 and 69 was conceived by the inventors at least by December 11, 2000 which is before the December 28, 2000 filing date of Ito et al.

Accordingly, the Applicants submit that Ito et al. is unavailable as a prior art reference against Claims 60 and 69 of the present application, and therefore respectfully request that the rejection of Claims 60 and 69 be withdrawn.

In section 9 of the Office Action, the Examiner rejected Claim 62 under 35 U.S.C. § 103(a) as being unpatentable over Ito et al. and SDA and further in view of Rajchel (U.S. Patent No. 6,272,575).

Applicants respectfully traverse these rejections. Each of these rejections relies in part on the use of Ito et al. However, Applicants submit that Ito et al. is unavailable as a prior art reference against Claim 62 of the present application. A Declaration of the inventors pursuant to 37 CFR § 1.131 has been provided herewith which provides evidence that the subject matter recited in Claim 62 was invented prior to the filing date of Ito et al. Ito et al. was filed on December 28, 2000 as U.S. Patent Application No. 09/748,856. The attached signed Declaration establishes that the subject matter recited in Claim 62 was conceived at least by December 11, 2000. Attachments to the Declaration include an Invention Disclosure form that establishes that the subject matter recited in Claim 62 was conceived by the inventors at least by December 11, 2000 which is before the December 28, 2000 filing date of Ito et al.

Accordingly, the Applicants submit that Ito et al. is unavailable as a prior art reference against Claim 62 of the present application, and therefore respectfully request that the rejection of Claim 62 be withdrawn.

In section 10 of the Office Action, the Examiner rejected Claims 63 and 65 under 35 U.S.C. § 103(a) as being unpatentable over Ito et al. and SDA and further in view of Jones et al. (U.S. Patent No. 6,438,638).

Applicants respectfully traverse these rejections. Each of these rejections relies in part on the use of Ito et al. However, Applicants submit that Ito et al. is unavailable as a prior art reference against Claims 63 and 65 of the present application. A Declaration of the inventors

pursuant to 37 CFR § 1.131 has been provided herewith which provides evidence that the subject matter recited in Claims 63 and 65 was invented prior to the filing date of Ito et al. Ito et al. was filed on December 28, 2000 as U.S. Patent Application No. 09/748,856. The attached signed Declaration establishes that the subject matter recited in Claims 63 and 65 was conceived at least by December 11, 2000. Attachments to the Declaration include an Invention Disclosure form that establishes that the subject matter recited in Claims 63 and 65 was conceived by the inventors at least by December 11, 2000 which is before the December 28, 2000 filing date of Ito et al.

Accordingly, the Applicants submit that Ito et al. is unavailable as a prior art reference against Claims 63 and 65 of the present application, and therefore respectfully request that the rejection of Claims 63 and 65 be withdrawn.

In section 11 of the Office Action, the Examiner rejected Claim 68 under 35 U.S.C. § 103(a) as being unpatentable over Ito et al. and SDA and further in view of Harari et al. (U.S. Patent No. 6,266,724).

Applicants respectfully traverse these rejections. Each of these rejections relies in part on the use of Ito et al. However, Applicants submit that Ito et al. is unavailable as a prior art reference against Claim 68 of the present application. A Declaration of the inventors pursuant to 37 CFR § 1.131 has been provided herewith which provides evidence that the subject matter recited in Claim 68 was invented prior to the filing date of Ito et al. Ito et al. was filed on December 28, 2000 as U.S. Patent Application No. 09/748,856. The attached signed Declaration establishes that the subject matter recited in Claim 68 was conceived at least by December 11, 2000. Attachments to the Declaration include an Invention Disclosure form that establishes that the subject matter recited in Claim 68 was conceived by the inventors at least by December 11, 2000 which is before the December 28, 2000 filing date of Ito et al.

Accordingly, the Applicants submit that Ito et al. is unavailable as a prior art reference against Claim 68 of the present application, and therefore respectfully request that the rejection of Claim 68 be withdrawn.

In section 12 of the Office Action, the Examiner rejected Claims 1-3, 14, 18-21, 23-26, 37, 41-44, and 46 under 35 U.S.C. § 103(a) as being unpatentable over Harari et al. (U.S. Patent No. 6,266,724) in view of SDA, Jones et al. (U.S. Patent No. 6,438,638), and further in view of Friend et al. (U.S. Published Application No. U.S. 2001/0032165). The Examiner indicated that Harari and SDA do not explicitly disclose the expansion slot configured to selectively couple to one of a secure digital card and a multimedia card and that Jones et al. teaches a slot configured to selectively couple to one of an SD card and an MMC. Applicants respectfully submit that what is claimed by Applicants is not simply having an expansion slot receiving an SD card or an MMC. What is recited in Applicants' amended independent Claim 1 is that the expansion device itself has an SDIO interface that is configured to be coupled with the handheld computer in a slot in the housing of the handheld computer and that the expansion slot of the expansion device also contains an SDIO interface which may receive an SD card or an MMC. What is taught by the references provided by the Examiner, in particular Harari et al. and Jones et al. is a device which receives one type of card and is used as a converter for an interface for another type of card. For example, what is disclosed and taught in Harari et al. and Jones et al. is that a card such as a PCMCIA card is received in a PCMCIA slot. The PCMCIA card then receives a different type of card having a different type of interface. For example, the PCMCIA card of Jones et al. includes a compact flash (CF) interface such that a CF card is received into the PCMCIA card which in turn is received into the PCMCIA slot of the computer.

What is not taught by any of the references is that the interface in the handheld computer is the same as the interface in the expansion slot. What is taught by Applicants is that the expansion device is used in a situation in which there is only one slot in the handheld computer. However, a user wishes to use an SDIO card as an expansion device such as for a peripheral device like a camera, etc. and also wishes to use an SD memory card which the user already has



because the user uses it in many situations with the handheld computer. So, an expansion slot is provided in the expansion device such that the handheld computer user has access to the SDIO expansion device as well as the SD card which may reside in the expansion device for the handheld computer. What is taught in the references is the use of a converter card and therefore the references do not contemplate the use of the same interface in the expansion slot as the interface used in the handheld computer because what Applicants have conceived is not a converter device as is shown in the references. For this reason alone, Applicants respectfully submit that no combination of Harari et al., SDA, Jones et al., and Friend et al. discloses, teaches, or suggests all of the claim limitations of independent Claims 1 and 24 because the same interface is not used in the expansion slot as in the handheld computer. The references disclose only the use of a converter having a first interface for interfacing with a computer and a second interface which is different from the first interface for interfacing with a memory card, e.g. Accordingly, the subject matter recited in independent Claims 1 and 24 is not disclosed, taught, or suggested by the combination of the cited references. Thus, independent Claim 1 and 24 and their dependent claims are allowable.

Even if the claim limitations discussed above could be found in the cited references, the cited references do not disclose the SDIO module housing configured to be located adjacent and parallel with a back side of the handheld computer. The Examiner has cited Friend et al. to teach the slot being formed in a side or back of a computer. However, what is not taught by Friend is that the housing which defines the slot is located adjacent and parallel with a back side of the handheld computer. Again, this is important to a handheld computing device having an accessory device such that the accessory device in combination with the expansion slot is sufficiently out of the way of a user of the device. This fact is fully disclosed as one refers to the Figures 2, 3, 4, and 5 which show how the slot and SDIO module housing may be provided out of the way of a user adjacent and parallel with the back side of the handheld computer. Thus, Applicants respectfully submit that because the SDIO module housing configured to be located adjacent and parallel with the back side of the handheld computer is not disclosed, taught, or

suggested alone or in combination of the cited references, Claims 1 and 24 and their respective dependent claims are allowable.

In section 13 of the Office Action, the Examiner rejected Claims 4-5 and 27-28 under 35 U.S.C. § 103(a) as being unpatentable over Harari et al. in view of SDA, Jones et al., and Friend et al., and further in view of Petty (U.S. Patent No. 6,389,486). The Examiner indicates that the application of Petty is used for the teaching of a positioning system device (GPS card). Accordingly, Applicants maintain that for the reasons provided with regard to independent Claims 1 and 24, Claims 4-5 and 27-28 are allowable.

In section 14 of the Office Action, the Examiner rejected Claims 6-7 and 29-30 under 35 U.S.C. § 103(a) as being unpatentable over Harari et al. in view of SDA, Jones et al., and Friend et al., and further in view of Hawkins et al. (U.S. Patent No. 6,442,637). The Examiner has indicated that the application of Hawkins is used to teach an expansion audio player (MP3 player) coupled to a mobile computer. Accordingly, because Hawkins et al. is used to teach the added limitation, Applicants maintain that Claims 6-7 and 29-30 are allowable for the reasons provided with regard to independent Claims 1 and 24.

In section 15 of the Office Action, the Examiner rejected Claims 8-9, 16, 22, 31-32, 39, and 45 under 35 U.S.C. § 103(a) as being unpatentable over Harari et al. in view of SDA, Jones et al., and Friend et al., and further in view of Ito et al. The Examiner has applied Ito et al. to teach a voice recorder accessory device coupled to an expansion module, a pedometer, a rechargeable battery, and a Bluetooth transceiver. Applicants respectfully submit that with regard to Claims 8-9, 16, 22, 31-32, 39, and 45, the arguments with regard to independent Claims 1 and 24 are applicable and therefore Claims 8-9, 16, 22, 31-32, 39, and 45 are allowable.

In section 16 of the Office Action, the Examiner rejected Claims 10 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Harari et al. in view of SDA, Jones et al., and Friend et al., and further in view of Jones (U.S. Patent No. 6,145,046). Applicants respectfully submit that the Examiner has applied the Jones reference to teach a digital camera using a memory card.

Applicants respectfully submit that for the reasons provided with regard to independent Claims 1 and 24, Claims 10 and 33 are allowable.

In section 17 of the Office Action, the Examiner rejected Claims 11-13 and 34-36 under 35 U.S.C. § 103(a) as being unpatentable over Harari et al. (U.S. Patent No. 6,266,724) in view of SDA, Jones et al., Friend et al., and further in view of Nakashima (U.S. Patent No. 6,182,204). Applicants respectfully submit that Nakashima has been applied by the Examiner for the disclosure of an FM tuner and television tuner. Applicants respectfully submit that even with the disclosure of Jones, the arguments with regard to independent Claims 1 and 24 are still applicable, thus, Claims 11-13 and 34-36 are allowable.

In section 18 of the Office Action, the Examiner rejected Claims 15 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Harari et al. in view of SDA, Jones et al., and Friend et al., and further in view of Yu (U.S. Patent No. 6,362,794). The application of Yu is used by the Examiner to teach a wireless networking card. Applicants respectfully submit that the arguments made with regard to independent Claims 1 and 24 are still applicable and that Claims 15 and 38 are therefore allowable.

In section 19 of the Office Action, the Examiner rejected Claims 17 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Harari et al. in view of SDA, Jones et al., and Friend et al., and further in view of Rajchel (U.S. Patent No. 6,272,575). The Examiner has indicated that Rajchel discloses a card module to receive cellular telephone transceivers to be used with a handheld computer. Applicants respectfully submit that the arguments made with regard to independent Claims 1 and 24 are applicable and therefore Claims 17 and 40 are therefore allowable.

\* \* \* \* \*

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date January 21, 2005

By Alistair K. Chan

FOLEY & LARDNER LLP  
777 East Wisconsin Avenue  
Milwaukee, Wisconsin 53202-5306  
Telephone: (414) 297-5730  
Facsimile: (414) 297-4900

Alistair K. Chan  
Attorney for Applicants  
Registration No. 44,603